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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,212	11/06/2003	Steve Davis	16222U-016100US	2931
66945 7590 03/09/2009 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
WORJLOH, JALATIE				
ART UNIT		PAPER NUMBER		
3685				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/705,212

Applicant(s)

DAVIS, STEVE

Examiner

Jalatee Worjloh

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-17, 19-26, 28-38 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, 19-26, 28-38, 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed December 22, 2008.
2. Claims 1-8, 10-17, 19-26, 28-38, 41-44 are pending.

Response to Arguments

3. Applicant's arguments filed December 22, 2008 have been fully considered but they are not persuasive.
4. Applicant argues that Breck does not teach "wherein the pseudonym is used for authentication"; however, the wherein clause merely expresses the intended results; therefore, it does not limit the claim and is not given patentably weight (see MPEP 2111.04)
5. Applicant argues that Break does not teach the merchant system analyzes the authentication response "to determine if the electronic commerce card account number has been successfully authenticated", this is also an intended use feature. Functional recitation(s) using the word "for" or other functional language (e.g. "to determine") have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

6. Applicant argues that Breck does not expressly disclose “wherein the authentication response includes a second HTTP redirect command comprising the address of the merchant”; however, the specification does not provide support for this feature. Also, arguments with respect to this feature have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Breck does not expressly disclose “wherein the cardholder system thereafter forwards the authentication response to the merchant system”; however, the wherein clause merely expresses the intended results; therefore, it does not limit the claim and is not given patentable weight (see MPEP 2111.04).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-8, 10-17, 19-26, 28-38, 41-44 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

although all limitations must be considered, not all limitations are entitled to patentable weight).

claimed invention. For instance, claim 1 recites “wherein the authentication response includes a second HTTP redirect command comprising the address of the merchant, wherein the cardholder system thereafter forwards the authentication response to the merchant system”; however, the Specification does not support these features. If Applicant disagrees, please indicate where these features are described.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 7, 8, 10, 11, 16, 17, 19, 20, 25, 26, 32, 33, 38, 41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2005/0021781 to Sunder et al. (“Sunder”) and of US Publication No. 2004/0158532 to Breck et al. (“Breck”) in view of US Publication No. 2004/0177047 to Graves et al. (“Graves”).

Referring to claim 1, Sunder discloses receive an authentication request from a cardholder system (i.e. client device)(see paragraphs [0005] & [0007]), forward the authentication request to an access control server (see paragraph [0008]), relay authentication information between the access control server and the cardholder system receive an authentication response from the access control server and forward the authentication response to the cardholder system (see paragraphs [[0010] & [0011]). Sunder does not expressly disclose wherein the authentication request was previously forward from a merchant system using an

HTTP redirect command comprising the address of the central transaction server, wherein the authentication request includes a pseudonym corresponding to an electronic commerce card account number, wherein the pseudonym expires after a predetermined period of time, wherein the pseudonym is used for authentication, wherein the central transaction server initiates a payment request process, wherein the authentication response includes a second HTTP redirect command comprising the address of the merchant, wherein the cardholder system thereafter forwards the authentication response to the merchant system, wherein the merchant system analyzes the authentication response to determine if the electronic commerce card account number has been successfully authenticated and submits the electronic commerce card account number. Breck discloses wherein the authentication request was previously forward using an HTTP redirect command comprising the address of the central transaction server (see paragraph [0070]), wherein the authentication request includes a pseudonym corresponding to an electronic commerce card account number, wherein the pseudonym expires after a predetermined period of time (see paragraphs [0080], [0048], and [0056]) and wherein the central transaction server initiates a payment request process by submitting the electronic commerce card account number to an issuer of the electronic commerce card account number(see paragraph [0091]). Graves discloses includes a second HTTP redirect command comprising the address of the merchant, wherein the cardholder system thereafter forwards the authentication response to the merchant system, wherein the merchant system analyzes the authentication response to determine if the electronic commerce card account number has been successfully authenticated (see paragraphs [0052] – 1st HTTP direct, [0055] -[0059] – 2nd HTTP direct) . As for the feature, “wherein the pseudonym is used for authentication”, the wherein clause merely expresses the intended results;

therefore, it does not limit the claim and is not given patentably weight (see MPEP 2111.04). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the elements taught by Breck and Graves. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security.

Referring to claim 2, Sunder discloses and electronic commerce card authentication system (see claim 1 above). Sunder does not expressly discloses the system wherein the authentication response is translated to a format compatible with a merchant system. Breck discloses the system wherein the authentication response is translated to a format compatible with a merchant system (see paragraphs [0054] and [0082]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the elements of Breck. One of ordinary skill in the art would have been motivated to do this because it provides a means for the merchant system to read and process the message.

Referring to claims 7 and 8, Sunder discloses an electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose wherein a pseudonym was previously created by the central transaction server or the pseudonym was created by a merchant system. Breck discloses the system wherein a pseudonym was previously created by the central transaction server or the pseudonym was created by a merchant system (see claim 1 above and paragraph [0052]).

Claims 10, 19, 32 and 33 are rejected on the same rationale as claim 1 above.

Claims 11 and 20 are rejected on the same rationale as claim 2 above.

Claims 16 and 25 are rejected on the same rationale as claim 7 above.

Claims 17 and 26 are rejected on the same rationale as claim 8 above.

Referring to claim 38, Sunder discloses an authentication server (see claim 1 above). Sunder does not expressly disclose the server hosts at least one web page. Breck discloses an authentication server that hosts at least one web page (see claim 1 above). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the process where the authentication server hosts at least one web page. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security.

Referring to claim 41, Sunder discloses an authentication server (see claim 1 above). Sunder does not expressly disclose a pseudonym with the predetermined time in five minutes. Breck discloses the pseudonym with a predetermined time, but does not explicitly state that the time is in five minutes (see claim 1 above). However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The feature where the central transaction server receives a request would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 UPSQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive a request including any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of

the data does not patentably distinguish the claimed invention.

As per claims 43 and 44 (see claims 1 and 10 rejection above).

11. Claim 3, 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder and Breck as applied to claims 1, 10 and, 19 above, and further in view of U.S. Publication No. 2003/0046541 to Gerdes et al. ("Gerdes").

Referring to claim 3, Sunder discloses an electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose wherein the central transaction server is adapted to forward a copy of the authentication response to an authentication history server to be archived. Gerdes discloses a central transaction server that forwards a copy of an authentication response to an authentication history server to be archived (see paragraph [0057]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include a copy of the authentication response to an authentication history server. One of ordinary skill in the art would have been motivated to do this because it provides a history of authentication transaction (see paragraph [0057] of Gerdes).

Claims 12 and 21 are rejected on the same rationale as claim 3 above.

12. Claims 4-6, 13-15, 22-24, and 28 -31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunder and Breck as applied to claims 1, 10 above, and further in view of US Publication No. 2004/0254848 to Golan et al. ("Golan").

Referring to claims 4 and 5, Sunder discloses the electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose wherein the

central transaction server further receives a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is sends the verifying enrollment response in response to a query to the access control server. Golan discloses wherein the central transaction server further receives a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server is adapted to send the verifying enrollment response in response to a query to the access control server (see paragraphs [0094]-[0097] & claims 5,6). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the system wherein the central transaction server receives a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server; wherein the central transaction server sends the verifying enrollment response in response to a query to the access control server. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

Referring to claim 6, Sunder discloses the electronic commerce card authentication system (see claim 1 above). Sunder does not expressly disclose the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request. Golan discloses the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request (see paragraphs [0099] & [0100]). At the time

the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the system wherein the central transaction server is adapted to send the verifying enrollment response to the directory server with or without querying the access control server, and is further adapted to query the access control server in response to receiving an authentication request. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

Claims 13, 22, 28, and 30 are rejected on the same rationale as claim 4 above.

Claims 14 and 23 are rejected on the same rationale as claim 5 above.

Claims 15 and 24 are rejected on the same rationale as claims 6 above.

Referring to claims 29 and 31, Sunder discloses the electronic commerce card authentication system (see claims 28 and 30 respectively above). Sunder does not expressly disclose modifying the verifying enrollment request from a directory server, and forwarding the modified verifying enrollment response to the directory server. Golan discloses receiving a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server and sending the verifying enrollment response in response to a query to the access control server (see paragraphs [0094]-[0097] & claims 5,6). Golan does not teach the request being modified; however, the concept of modifying data is well known in the art of data processing. Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the steps of disclose receiving a verifying enrollment request from a directory server, and to send a verifying enrollment response to the directory server and sending the verifying enrollment response in

response to a query to the access control server. One of ordinary skill in the art would have been motivated to do this because provides an additional level of verification, thereby securing the system.

13. Claims 34- 37 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over to Sunder and Breck in view of Golan.

Referring to claim 34, Sunder discloses receiving an authentication request from a holder system (i.e. client device) (see paragraphs [0005] & [0007]), sending the authentication request with the pseudonym to the access control server (see paragraph [0008]), receiving an authentication response and sending the authentication response to the holder system (see paragraphs [[0010] & [0011]). Sunder does not expressly disclose receiving a verifying enrollment request, sending the verifying enrollment response to an access control server, receiving a verifying enrollment response from the access control server, creating an altered verifying enrolling response comprising a pseudonym, sending the altered verifying enrollment response to a merchant system, wherein the merchant system subsequently sends an authentication request including the pseudonym to a holder system, wherein the authentication request including the pseudonym sent to the holder system further comprises a web page containing a redirect command, wherein the redirect command is an HTTP redirect command, comprising the address of the central transaction server, wherein the pseudonym expires after a predetermined period of time. Golan discloses receiving a verifying enrollment request, sending the verifying enrollment response to an access control server, receiving a verifying enrollment response from the access control server (see paragraphs [0094] – [0097] & claims 5, 6). Breck discloses creating an altered verifying enrolling response comprising a pseudonym, sending the

altered verifying enrollment response to a merchant system, wherein the merchant system subsequently sends an authentication request including the pseudonym to a holder system, wherein the authentication request including the pseudonym sent to the holder system further comprises a web page containing a redirect command, wherein the redirect command is an HTTP redirect command, comprising the address of the central transaction server, wherein the pseudonym expires after a predetermined period of time (see paragraphs [0048], [0058], [0079], and [0080]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Sunder to include the elements taught by Golan and Breck. One of ordinary skill in the art would have been motivated to do this because it provides an additional level of security.

As for claims 35-37, Sunder teaches these steps (see claim 34 above).

Claim 42 is rejected on the same rationale as claim 41 above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685